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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,524	11/08/2001	Robert J. Lawton	10001593-1	2569

7590

09/16/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administraion  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/007,524

Applicant(s)

LAWTON, ROBERT J.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10, 12-14, 24-26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 12-14, 24-26 and 29 is/are rejected.
- 7) ☒ Claim(s) 8 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 7 (currently cancelled and included in claim 1), 10, 12, 14 and 27 is withdrawn in view of the reference to Schlough (5,975,823).

Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 5, 10, 12-14, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlough (5,975,823).

Schlough discloses a method of forming sheet material assemblage comprising a stack (14) of signatures (16) having folded edges (38) interconnected by pre-applied adhesive, the folded edges of the signatures are aligned with each other, pressure is applied against the outer sheets of the signatures to interconnect the inner and outer sheets of the signatures with adhesive, a presser wheel (72) is used to apply force against the cover (12) and signatures for a period of time to provide a cohesive bond between the cover and the signatures (see col. 2, lines 39-46 and 56-62 and col. 4, lines 6-24).

Regarding claim 4, the signatures are aligned with each other before pressing as set forth above.

Regarding claim 5, the adhesive is applied to the binding edges of the signatures before aligning as set forth above.

Regarding claim 10, see the above rejections to claim 1. Further, the inside of the cover is scored along fold lines (40, 42).

Regarding claims 12-14, Schlough discloses the claimed method as set forth in the above rejections to claim 1.

Regarding claims 24 and 25, Schlough discloses a publication binder inherently including an alignment system (since the signatures are to be aligned along the folded edges) and a pressure system having a clamp (since the signatures are pressed together with each other and a cover by a presser wheel 72).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 10, 12-14, 24-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmberg ('116) in view of Schlough, as used above.

Holmberg discloses a method comprising aligning individual sheets (10), the individual sheets having a pre-applied adhesive (10a – glue ribbon); and pressing the

sheets together to activate the adhesive on the sheets (see col. 2, lines 39-61 and col. 3, lines 10-12), wherein a cohesive bond is formed between the adhesive on the sheets producing the bound booklet (see col. 1, lines 27-36).

Holmberg discloses the claimed invention except for the pressing comprising rotating a roller over the first page to apply a pressure for a period of time that will activate the adhesive and form the cohesive bond.

Schlough discloses a method of forming sheet material assemblage comprising a stack (14) of signatures (16) having folded edges (38) interconnected by pre-applied adhesive, the folded edges of the signatures are aligned with each other, pressure is applied against the outer sheets of the signatures to interconnect the inner and outer sheets of the signatures with adhesive, a presser wheel (72) is used to apply force against the cover (12) and signatures for a period of time to provide a cohesive bond between the cover and the signatures (see col. 2, lines 39-46 and 56-62 and col. 4, lines 6-24). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holmberg's invention to include rotating a roller over the sheets, as taught by Schlough, to provide a secure, cohesive bond between the sheets.

Regarding claims 2, 3 and 29, Holmberg, as modified by Schlough, discloses the claimed invention except for explicitly disclosing a trimmer for trimming the sheets before aligning the sheets together. Holmberg, as modified by Schlough, discloses the sheets being prefabricated (i.e., manufactured in advance). The trimming operation is a conventional finishing process performed on individual sheets of paper. Therefore, it

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would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holmberg's invention to include trimming the edges of the sheet to enable proper alignment of the sheets in the bound publication.

Regarding claim 4, Holmberg, as modified by Schlough, discloses the sheets being secured prior to be pressed (see col. 2, lines 34-38 of Holmberg).

Regarding claim 5, Holmberg, as modified by Schlough, discloses applying the adhesive on a binding edge of the sheets before aligning (see col. 2, lines 19-28; the adhesive is pre-applied to the sheets of Holmberg).

Regarding claim 6, Holmberg, as modified by Schlough, discloses applying the adhesive to both sides of the sheet (as seen in col. 3, lines 36-41 and figure 8 of Holmberg).

Regarding claim 10, see the above rejections to claim 1. Further, the inside of the cover is scored along fold lines (40, 42).

Regarding claims 11 and 13, see the above rejections to claim 1.

Regarding claims 12-14, Holmberg, as modified by Schlough, discloses the method as set forth in the above rejections to claim 1.

Regarding claims 24 and 25, Holmberg, as modified by Schlough, discloses a publication binder (20) comprising an alignment system (upstanding paper abutment portion 22b of heater bar 22) to align sheets of a publication, the sheets having pre-applied adhesive (10a – glue ribbon) and a pressure system configured to apply a pressure to the sheets for a period of time to adhere the sheets together (as seen in col. 2, lines 34-61), the pressure system including a roller (72 – presser wheel of Schlough).

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Regarding claim 26, Holmberg, as modified by Schlough, discloses the alignment system including a clamp (25) configured to secure the sheets in place (as seen in col. 2, lines 52-57 of Holmberg).

### ***Allowable Subject Matter***

6. Claims 8 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-6, 10, 12-14, 24-26 and 29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 14, 2004

*Monica S. Carter*  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**